

REMARKS

The office action of October 28, 2008, has been carefully considered.

It is noted that the abstract of the disclosure and the specification are objected to on formal grounds.

Claim 8 is objected to for containing various informalities.

Claim 9 is objected to under 37 C.F.R. 1.75(c).

Claim 7 is rejected under 35 U.S.C. 101.

Claim 6 is rejected on the grounds of nonstatutory obviousness-type double patenting over claim 6 of U.S. Patent No. 7,367,209.

Claims 1-3, 5, 6, 8 and 9 are rejected under 35 U.S.C. 112, second paragraph.

Claims 5-7 are rejected under 35 U.S.C. 102(b) over the patent application of Haberkamm et al.

Claims 1-4, 8 and 9 are rejected under 35 U.S.C. 103(a) over Kaberkamm et al. in view of WO 02/11916 to Hartung et al. and the patent to Tateno et al.

In connection with the Examiner's objections to the application, applicant has attached hereto an Abstract of the Disclosure and has provided a substitute specification. No new matter has been added to the substitute specification.

In view of these considerations it is respectfully submitted that the objections to the application are overcome and should be withdrawn.

In view of the Examiner's rejections of the claims, applicant has canceled claims 7 and 8, and amended claims 1-3, 5, 6 and 9.

It is respectfully submitted that the claims now on file particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended the claims to address the instances of indefiniteness pointed out by the Examiner. Relative to claim 1, those skilled in the art would know the ordinal degree needed without more definition in

the claim.

In view of these considerations it is respectfully submitted that the rejections of claims 1-3, 5, 6, 8 and 9 under 35 U.S.C. 112, second paragraph are overcome and should be withdrawn.

Applicant has also amended claim 9 to address the informalities pointed out by the Examiner. Thus, it is respectfully submitted that the objection to claims 8 and 9 are overcome and should be withdrawn.

With the cancellation of claim 7 it is respected that the rejection of this claim under 35 U.S.C. 101 is overcome and should be withdrawn.

Relative to claim 6, applicant has submitted herewith a terminal disclaimer disclaiming the terminal portion of any patent issuing on the present application which might extend beyond the expiration of U.S. Patent No. 7,367,209. With this submission it is respectfully submitted that the rejection of claim 6 on the grounds of nonstatutory obviousness-type double patenting over claim 6 of U.S. Patent No. 7,367,209 is overcome and should be withdrawn.

It is respectfully submitted that the claims presently on file differ essentially and in an unobvious, highly advantageous manner from the constructions disclosed in the references.

Turning now to the references and particularly to the patent to Haberkamm et al., it can be seen that this patent discloses a method and device for band-edge orientated displacement of intermediate cylinders in a six cylinder frame. Applicant submits that Haberkamm et al. do not disclose a tandem cold rolling mill having the features now recited in claim 5. The features of original claim 8 have been incorporated into claim 5.

In view of these considerations it is respectfully submitted that the rejection of claims 5-7 under 35 U.S.C. 102(b) over the above-discussed reference is overcome and should be withdrawn.

**Statement of Common Ownership**

The present application and US 2003/0164020 were, at the time the invention of the present application was made, owned by, or subject to an obligation of assignment to SMS Demag AG.

**HM-717**

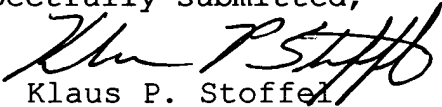
With the above statement it is submitted that US 2003/0164020 is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). Thus, it is respectfully submitted that the rejection of claims 1-4, 8 and 9 under 35 U.S.C. 103(a) is overcome and should be withdrawn.

Reconsideration and allowance of the present application are respectfully requested.

Any additional fees or charges required at this time in connection with this application may be charged to Patent and Trademark Office Deposit Account No. 11-1835.

Respectfully submitted,

By

  
Klaus P. Stoffel  
Reg. No. 31,668

For: Friedrich Kueffner


Reg. No. 29,482  
317 Madison Avenue, Suite 910  
New York, New York 10017  
(212) 986-3114

Dated: April 28, 2009

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450 Alexandria, VA 22313-1450, on April 28, 2009.

By:

  
Klaus P. Stoffel

Date: April 28, 2009